

## REMARKS

Claim 11 is cancelled in favor of new claim 12, entry of which is requested. The new method claim is supported by the original specification, *e.g.*, in paragraphs 0018 – 0025 of the published application, US 2006/0172675. Thus, the specification indicates that, “[a]s the fish fillet arrives [at] the first of the two [support] members, the [first] member is displaced outwardly and forms ... a pocket for one loin side” of the fillet (paragraph 0020). Compare initial step recited in claim 12.

In response to the restriction requirement, applicants provisionally elect claims 1 - 10 (Group I), drawn to an apparatus for removing bones from a fish fillet. This election is with traverse because Examiner Price's stated rationale for restriction of the claimed method is inapposite to claim 12, which therefore should be considered with the provisionally elected claims.

More specifically, elected claim 1 and claim 12 embody “specific technical features” in common, which features distinguish both claims over U.S. patent No. 6,322,437 to Grabau *et al.* These claims relate the action of first and second supporting means, whereby “an attractive force” is exerted “between said first and second support means,” an arrangement effected, for instance, “by means of mounting one or preferably a number of springs between the second supporting means and a position adjacent to the perpendicular side of the first supporting means” (specification, paragraph 0018).

In sharp contrast, the Grabau patent describes an apparatus having two cutting units, both of which comprise bone guides. The cutting units cut the fillets from the fish skeleton in a manner such that the cutting edges point towards the conveying direction of a conveying belt. See, *e.g.*, column 2, lines 18 - 62. There is no suggestion in Grabau of means for providing an attractive force between two support means that interact with the fillet.

Accordingly, the aforementioned language of applicants' independent claims, product as well as method, does distinguish the presently claimed invention over the Grabau patent. Withdrawal of the restriction and examination of all pending claims together are warranted, therefore.

Examiner Price is invited to contact the undersigned directly, should he feel that further consideration of any issue would advance the prosecution. Otherwise, an early and favorable disposition of the present case is requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 CFR §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 25 September 2006

By S. A. Bent

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

Stephen A. Bent  
Attorney for Applicant  
Registration No. 29,768